REMARKS

Applicants request favorable reconsideration and withdrawal of the rejections set forth in the above-noted Office Action in view of the foregoing amendments and following remarks.

Claims 1, 2, 4, 6, 7, and 9-21 are now pending, with claims 1 and 12 being independent claims. Claims 1 and 12 have been amended. Support for the amendments can be found throughout the originally-filed disclosure. Accordingly, Applicants submit that the amendments do not include new matter.

Section 101 Non-Statutory Subject Matter Rejection

Claims 1 and 12 are rejected in the Office Action under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. In particular, the Office Action asserts the methods of these claims are related to a mental processes that is not patentable. The Office Action suggests inserting a device in the "essential steps" of the claims, such as the recited developing or performing data analysis steps.

Applicants respectfully traverse the rejection, and traverse the assertion in the Office Action that the developing and performing data analysis steps represent "essential steps" of the claimed invention. Nevertheless, Applicants thank the Examiner for the suggestion as to how the Section 101 rejection could be overcome, and have adapted the suggestion by the amendments herein. Specifically, amended independent claims 1 and 12 recite that a computer is used for the developing and performing data analysis steps. Accordingly, Applicants submit that the Section 101 rejection has been overcome.

Obviousness-Type Double Patenting Rejection

Claims 1-21 are provisionally rejected in the Office Action on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 65 and 67-71 of copending Application No. 10/304,251 ("the '251 Application").

Initially, Applicants note that, subsequent to the Office Action, the '251 Application issued as U.S. Patent No. 7,613,629 ("the '629 Patent").

Applicants further note that neither the '251 Application nor the '629 Patent includes "claims 65 and 67-71," as asserted in the Office Action. Further, neither the claims of the '251 Application nor the '629 Patent, recite a "purchaser profile," as is referred to in the Office Action. Accordingly, Applicants submit that the formulation of this double patenting rejection in the Office Action is incorrect.

Further, Applicants submit that the claims of the present application are patentably distinguishable from the claims of the '629 Patent inasmuch as the claims of the present application include several features not recited in the claims of the '629 Patent. For example, the claims of the '629 Patent do not recite or otherwise suggest performing data analysis using a computer and using standardized information, as recited in combination with the other features of independent claims 1 and 12 of the present application.

Thus, for at least the forgoing reasons, Applicants submit that the claimed invention of the present application is patentably distinguishable from the claimed invention of the '629 Patent, and the obviousness-type double patenting rejection should be withdrawn.

Nonstatutory Double Patenting Rejections

Claims 1-21 are rejected in the Office Action on the ground of nonstatutory double patenting as being unpatentable over claims 1-15, 41, 55-57, and 60-68 of U.S. Patent No.

7,398,225 ("the '225 Patent"). Claims 1-21 are also rejected on the ground of nonstatutory double patenting over claims 1-5, 8-15, and 18-20 of U.S. Patent No. 7,467,096 ("the 096 Patent").

Initially, Applicants note that these rejections are not based on the more common "obviousness-type" double patenting, but rather on the type of double patenting rejection set forth in In re Scheller, 397 F.2d 350 (CCPA).

Applicants respectfully traverse these rejections on their merits, and on the grounds that the Office Action has not followed procedures mandated at MPEP § 804(B)(2) for this type of double patenting rejection. As noted in this section of the MPEP:

> The decision in In re Schneller did not establish a rule of general application and **thus is limited to the particular set of facts set forth in that decision** . . . Nonstatutory double patenting rejections based on Schneller **will be rare**. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on Schneller. If an examiner determines that a double patenting rejection based on Schneller is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.

(first emphasis added)

The Office Action makes no finding that facts of the present application are the analogous to the facts of the Schneller case. And indeed, Applicants submit that the present application does not involve the issues of Schneller. In Schneller, the court found as part of the basis for the double patenting rejection that the appealed claims were fully covered by the claims of the patents asserted in the rejection. 397 F.2d at 355. However, neither of the claims of the '225 Patent nor the claims of the '096 Patent "cover" the claims of the present application. In this regard, the Schneller court set forth the "covering" meant the claims of the references for the

double patenting rejection "read on" the appealed claims. See 397 F.2d at 353. In the present case, neither of the claims of the of the '225 Patent or the '096 Patent recite a step of performing data analysis using a computer and using standardized information as in the claimed invention. On the other hand, the claims of the '225 Patent and the '096 Patent both include features not found in the claims of the present application. Thus, the claims of the '225 and '096 Patents fail to cover, or "read on" the claims of the present application, as was required of the nonstatutory double patenting rejection set forth in Schneller.

Another fact cited by the Schneller court in its decision was that the granting of a patent of the appealed claims in the case would have unjustly extended the patent protection period for the invention. 397 F.2d at 354. Note that at the time of Schneller, patent term was calculated based on the issue date of the patent. See MPEP § 2701. The subsequent change is law to calculating patent term based on the earliest claimed filing date, and the facts of the present case, show that "unjust extension" of the presently claimed invention will not be an issue, unlike the Schneller case. Both present application and the '096 Patent claim priority under 35 U.S.C. § 120 to the application that led to the '225 Patent. Thus, the present application will have substantially the same term as the '096 and '225 Patents, based its common filing date with the '225 Patent (with variations only based on statutorily mandated patent term adjustments). Id.

Accordingly, Applicants submit that the facts of the Schneller case are not present in this application, and therefore the rejection based on nonstatutory double patenting in the Office Action should be withdrawn. See MPEP § 804(B)(2).

Section 101 Utility Rejection

Claims 1-21 are rejected in the Office Action under 35 U.S.C. § 101 as lacking patentable utility in the claims because they do not specify what type of analysis is being performed with the standardized information.

Applicants traverse this utility rejection on multiple grounds.

Initially, Applicants traverse the Office Action's implicit requirement that the claim language itself must actually recite a specific utility. Unlike evaluations for statutory subject matter under Section 101, novelty under Section 102, obviousness under Section 103, and definiteness under Section 112, the evaluation of utility of an invention under Section 101 is not strictly limited to claim language. For example, MPEP § 2107 mandates: "[i]f the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., it has a "specific and substantial utility") and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility." Further, MPEP § 2107.02 notes "the examiner should review *the specification* to determine if there are any statements asserting that the claimed invention is useful for any purpose." (emphasis added). In fact, as noted at MPEP § 2107.02(II)(A), if an invention has a well-established utility, the applicant need not even provide a specific statement of utility. Clearly, there is no requirement that the claim language itself recite a utility of the claimed invention.

In this case, Applicants submit that the disclosure of the application includes multiple statements regarding the utility of the claimed invention. See, e.g., paragraphs 0117 through 0128 of the specification. Accordingly, Applicants submit that the utility rejection is improper and should be withdrawn.

Additionally, if the utility rejection is to be maintained on the grounds that the claim language does not recite a specific utility, Applicants kindly request that the Office Action provide citation to specific authority (e.g., case law or MPEP) that utility requirement of Section 101 is based on the *claim language itself*, and not on the disclosure of the application as a whole.

Applicants also traverse the rejection on the grounds that the recitation in the claims of "performing data analysis" in an of itself establishes a utility. It is well established, and would be well understood by one of ordinary skill in the art, that data analysis is useful in numerous ways. Thus, the recitation of data analysis, as it now stands, satisfies the utility requirements of Section 101.

Accordingly, for at least the foregoing reasons, Applicants submit that the Section 101 utility rejection should be withdrawn.

* * * *

Applicants submit that the present application is in condition for allowance. Favorable reconsideration, withdrawal of the rejections set forth in the Office Action, and a Notice of Allowability are requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. Office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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